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10/022,861	12/13/2001	Tadaaki Saida	1232-4801	6336
27123	7590	12/13/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			TEACHEY, ROBERT	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 12/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/022,861	SAIDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert Teachey	2626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-2,4-27,29-53 is/are pending in the application.
- 4a) Of the above claim(s)    is/are withdrawn from consideration.
- 5) ☐ Claim(s)    is/are allowed.
- 6) ☒ Claim(s) 1,2,4-27 and 29-53 is/are rejected.
- 7) ☐ Claim(s)    is/are objected to.
- 8) ☐ Claim(s)    are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on    is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No.   .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. <u>  </u>  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/1/2004</u>  | 6) <input type="checkbox"/> Other: <u>  </u>                                |

**DETAILED ACTION**

**Notice to Applicant(s)**

1. This application has been examined. Claims 1-2, 4-27, and 29-53 are pending.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. The references listed in the information disclosure statement (IDS) submitted on 9/1/2004 have been considered by the examiner.

***Claim Objections***

Claims 45 and 46 are objected to because of the following informalities:

In the first line of the claims, "The control method according to claim 18" is incorrect because claim 18 is an apparatus claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 22 recites the limitation "size detector" in line 11 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 15, 40, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumagai et al. (hereinafter referred to as Kumagai ) (U.S. Patent 6,600,579).

With respect to claim 15, Kumagai discloses an image reading apparatus capable of performing a read-while-feed operation in which an original is read while being fed by an image sensor placed at a fixed position (column 3 lines 1-4), comprising: a detector adapted to detect presence/absence of dust and/or dirt on a platen (column 3 lines 62-64), a controller adapted to inhibit the read-while-feed operation in a case where said detector detects dust and/or dirt at all of a plurality of predetermined positions (column 3 lines 46-48, column 6 lines 46-47), and, in a case where said detector does not detect dust and/or dirt at least at one of the plurality of predetermined positions, control to perform the read-while-feed operation at the position where no dust or dirt is detected (column 6 lines 54-55);

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and an operation unit adapted to designate disabling of said detector, wherein said controller disables said detector in response to the designation by said operation unit (column 5 lines 63-67).

9. Claims 40 and 52 arguments are analogous to those presented for claim 15 therefore the arguments presented for claim 15 are applicable.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4, 5, 6, 7, 8, 9, 11, 13, 26, 27, 29, 30, 31, 32, 33, 34, 36, 38, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai et al. (hereinafter referred to as Kumagai ) (U.S. Patent 6,600,579) in view of Takashimizu et al. (hereinafter referred to as Takashimizu) (U.S. Patent 5,956,161).

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With respect to claim 1 Kumagai discloses an image reading apparatus capable of performing a read-while-feed operation in which an original is read while being fed by an image sensor placed at a fixed position (column 3 lines 1-4), comprising: a detector adapted to detect presence/absence of dust and/or dirt on a platen (column 3 lines 62-64), a controller adapted to inhibit the read-while-feed operation in a case where dust and/or dirt are detected at all of a plurality of predetermined positions by said detector (column 3 lines 46-48, column 6 lines 46-47), notify the presence of dust and/or dirt via a notification unit (column 4 lines 57-58), and allow the read-while-feed operation when removal of dust and/or dirt on the platen is detected in a state that the read-while-feed operation is inhibited (column 4 lines 59-62), a document feeder for feeding an original to the platen (column 3 lines 2-4).

The apparatus disclosed by Kumagai differs from claim 1 in that Kumagai does not disclose that said controller determines that dust and/or dirt on the platen is removed in response to an opening operation of the document feeder.

Takashimizu discloses said controller determines that dust and/or dirt on the platen is removed in response to an opening operation of the document feeder (column 14 lines 24-27; column 17 lines 31-32, 37-39, 42-43).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Kumagai wherein said

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controller determines that dust and/or dirt on the platen is removed in response to an opening operation of the document feeder. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Kumagai by the teaching of Takashimizu so that Kumagai's invention could assure precision in image reading for a long period of time (given the express suggestion of Takashimizu column 17 lines 22-24).

12. Claims 26 and 51 arguments are analogous to those presented for claim 1 therefore the arguments presented for claim 1 are applicable.

With respect to claim 2 Kumagai discloses an operation unit adapted to designate to clean the platen, wherein said controller determines that dust and/or dirt on the platen is removed when cleaning of the platen is designated from the operation unit (column 3 lines 65-67).

13. Claim 27 arguments are analogous to those presented for claim 2 therefore the arguments presented for claim 2 are applicable.

With respect to claim 4 Kumagai discloses when said detector does not detect dust and/or dirt at least at one of the plurality of predetermined positions, said controller controls to perform the read-while-feed operation at the position where no dust or dirt is detected (column 6 lines 44-51).



14. Claim 29 arguments are analogous to those presented for claim 4 therefore the arguments presented for claim 4 are applicable.

With respect to claim 5 Kumagai discloses said controller controls said detector to perform detection after a read-while-feed operation (column 4 lines 38-40).

15. Claim 30 arguments are analogous to those presented for claim 5 therefore the arguments presented for claim 5 are applicable.

With respect to claim 6 Kumagai discloses if said detector detects dust or dirt at all of the plurality of predetermined positions, said controller notifies the presence of the dust or dirt on the platen via the notification unit right after the detection (column 3 lines 66-67, column 4 lines 57-58).

16. Claim 31 arguments are analogous to those presented for claim 6 therefore the arguments presented for claim 6 are applicable.

With respect to claim 7 Kumagai discloses if said detector detects dust or dirt at all of the plurality of predetermined positions, said controller notifies the presence of the dust or dirt on the platen via the notification unit in advance of a reading operation of an original (column 3 lines 66-67, column 4 lines 11-15).

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17. Claim 32 arguments are analogous to those presented for claim 7 therefore the arguments presented for claim 7 are applicable.

With respect to claim 8 Kumagai discloses the notification unit comprises a display device, and the apparatus further comprises an operation unit adapted to designate to clear the displayed notification of the presence of the dust or dirt (column 4 lines 57-60).

18. Claim 33 arguments are analogous to those presented for claim 8 therefore the arguments presented for claim 8 are applicable.

With respect to claim 9 Kumagai discloses a memory adapted to, when said detector does not detect dust and/or dirt at least at one of the plurality of predetermined positions, store the position having no dust or dirt, wherein said controller controls to perform the read-while-feed operation at the stored position (column 3 line 67; column 4 lines 1-2; column 6 lines 55-56).

19. Claim 34 arguments are analogous to those presented for claim 9 therefore the arguments presented for claim 9 are applicable.

With respect to claim 11 Kumagai discloses said controller turns on a flag indicative of inhibition of the read-while-feed operation upon inhibiting the read-

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while-feed operation, and turns off the flag upon allowing the read-while-feed operation (column 7 lines 13-16, 32-34).

20. Claim 36 arguments are analogous to those presented for claim 11 therefore the arguments presented for claim 11 are applicable.

With respect to claim 13 Kumagai discloses an operation unit adapted to designate disabling of said detector, wherein said controller disables said detector in response to the designation by said operation unit (column 5 lines 63-67).

21. Claim 38 arguments are analogous to those presented for claim 13 therefore the arguments presented for claim 13 are applicable.

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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23. Claims 10, 12, 14, 35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai in view of Takashimizu as applied to claim 1 above, and in further view of Harada (U.S. Patent 6,563,938).

With respect to claim 10, Kumagai as modified differs from claim 10 in that Kumagai as modified does not disclose said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor, and wherein if said detector detects dust or dirt at all of the plurality of predetermined positions, said controller sets to perform the stationary reading operation.

Harada discloses said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor (column 4 lines 52-55), and wherein if said detector detects dust or dirt at all of the plurality of predetermined positions, said controller sets to perform the stationary reading operation (column 5 lines 38-42).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Kumagai as modified wherein said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor, and wherein if said detector detects dust or dirt at all of the plurality of predetermined positions, said controller sets to perform the stationary

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reading operation. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Kumagai as modified by the teaching of Harada so that Kumagai's invention would allow a user to place a document original on the contact glass (given the express suggestion of Harada column 3 lines 49-50).

24. Claim 35 arguments are analogous to those presented for claim 10 therefore the arguments presented for claim 10 are applicable.

With respect to claim 12, Kumagai as modified discloses a flag determination unit for determining on/off of the flag indicative of inhibition of the read-while-feed operation (Kumagai column 7 lines 13-16).

With respect to claim 12, Kumagai as modified differs from claim 12 in that Kumagai as modified does not disclose said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor, and wherein said controller controls to perform the stationary reading operation when said flag determination unit determines that the flag is on, and controls to perform the read-while-feed operation when said flag determination unit determines that the flag is off.

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Harada discloses said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor(column 4 lines 52-55), and wherein said controller controls to perform the stationary reading operation when said flag determination unit determines that the flag is on, and controls to perform the read-while-feed operation when said flag determination unit determines that the flag is off (column 5 lines 20-21, 24-26).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Kumagai as modified wherein said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor, and wherein said controller controls to perform the stationary reading operation when said flag determination unit determines that the flag is on, and controls to perform the read-while-feed operation when said flag determination unit determines that the flag is off. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Kumagai as modified by the teaching of Harada so that Kumagai's invention would allow a user to place a document original on the contact glass (given the express suggestion of Harada column 3 lines 49-50).

25. Claim 37 arguments are analogous to those presented for claim 12 therefore the arguments presented for claim 12 are applicable.

With respect to claim 14, Kumagai as modified differs from claim 14 in that Kumagai as modified does not disclose a size detector adapted to detect a size of an original, wherein plural sets of positions are prepared for different sizes of originals to be read as said plurality of predetermined positions, and said controller controls said detector to perform the detection at a plurality of predetermined positions depending upon the detected size of the original.

Harada discloses a size detector adapted to detect a size of an original, wherein plural sets of positions are prepared for different sizes of originals to be read as said plurality of predetermined positions, and said controller controls said detector to perform the detection at a plurality of predetermined positions depending upon the detected size of the original (column 4 lines 65-67; column 5 lines 1-3; column 6 lines 6-14).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Kumagai as modified wherein a size detector adapted to detect a size of an original, wherein plural sets of positions are prepared for different sizes of originals to be read as said plurality of predetermined positions, and said controller controls said detector to perform the detection at a plurality of predetermined positions depending upon the detected size of the original . It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Kumagai as

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modified by the teaching of Harada so that Kumagai's invention could be finely adjusted to shift the reading position for different sizes of originals (given the express suggestion of Harada column 5 lines 3-9).

26. Claim 39 arguments are analogous to those presented for claim 14 therefore the arguments presented for claim 14 are applicable.

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai et al. (hereinafter referred to as Kumagai ) (U.S. Patent 6,600,579) in view of Harada (U.S. Patent 6,563,938).

With respect to claim 16 Kumagai discloses an image reading apparatus capable of performing a read-while-feed operation in which an original is read while being fed by an image sensor placed at a fixed position (column 3 lines 1-4), comprising: a detector adapted to detect presence/absence of dust and/or dirt



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on a platen (column 3 lines 62-64), and a controller adapted to inhibit the read-while-feed operation in a case where said detector does not detect dust and/or dirt at all of a plurality of predetermined positions (column 3 lines 46-48, column 6 lines 46-47), and, in a case where said detector does not detect dust and/or dirt at least at one of the plurality of predetermined positions, control to perform the read-while-feed operation at the position where no dust or dirt is detected (column 6 lines 44-51).

The apparatus disclosed by Kumagai differs from claim 16 in that Kumagai does not disclose that plural sets of positions are prepared for different sizes of originals to be read as said plurality of predetermined positions, and said controller controls said detector to perform the detection at a plurality of predetermined positions set in accordance with the size of the original.

Harada discloses that plural sets of positions are prepared for different sizes of originals to be read as said plurality of predetermined positions, and said controller controls said detector to perform the detection at a plurality of predetermined positions set in accordance with the size of the original (column 4 lines 65-67; column 5 lines 1-3; column 6 lines 6-14).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Kumagai wherein plural sets of positions are prepared for different sizes of originals to be read as said

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plurality of predetermined positions, and said controller controls said detector to perform the detection at a plurality of predetermined positions set in accordance with the size of the original. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Kumagai by the teaching of Harada so that Kumagai's invention could be finely adjusted to shift the reading position for different sizes of originals (given the express suggestion of Harada column 5 lines 3-9).

29. Claims 41 and 53 arguments are analogous to those presented for claim 16 therefore the arguments presented for claim 16 are applicable.

With respect to claim 17 Kumagai discloses said controller controls said detector to perform detection after a read-while-feed operation (column 4 lines 38-40).

30. Claim 42 arguments are analogous to those presented for claim 17 therefore the arguments presented for claim 17 are applicable.

With respect to claim 18 Kumagai discloses a notification unit for notifying presence of dust or dirt on the platen if said detector detects dust or dirt at all of the plurality of predetermined positions (column 3 lines 66-67; column 4 lines 57-58).

31. Claim 43 arguments are analogous to those presented for claim 18  
therefore the arguments presented for claim 18 are applicable.

With respect to claim 19 Kumagai discloses if said detector detects dust or dirt at all of the plurality of predetermined positions, said notification unit notifies the presence of the dust or dirt on the platen right after the detection (column 3 lines 66-67; column 4 lines 57-58).

32. Claim 44 arguments are analogous to those presented for claim 19  
therefore the arguments presented for claim 19 are applicable.

With respect to claim 20 Kumagai discloses if said detector detects dust or dirt at all of the plurality of predetermined positions, said notification unit notifies the presence of the dust or dirt on the platen in advance of a reading operation of an original (column 3 lines 66-67; column 4 lines 11-15).

33. Claim 45 arguments are analogous to those presented for claim 20  
therefore the arguments presented for claim 20 are applicable.

With respect to claim 21 Kumagai discloses the notification unit comprises a display device, and the apparatus further comprises an operation unit adapted to designate to clear the displayed notification of the presence of the dust or dirt (column 4 lines 1-3, 59-60).

34. Claim 46 arguments are analogous to those presented for claim 21 therefore the arguments presented for claim 10 are applicable.

With respect to claim 22 Kumagai discloses a memory adapted to, when said detector does not detect dust and/or dirt at least at one of the plurality of predetermined positions, store the position having no dust or dirt in relation with a size of a document detected by said size detector, wherein said controller controls to perform the read-while-feed operation at the stored position (column 3 line 67; column 4 lines 1-2; column 5 lines 55-56).

35. Claim 47 arguments are analogous to those presented for claim 22 therefore the arguments presented for claim 22 are applicable.

With respect to claim 23 Harada discloses said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor (column 4 lines 52-55), and wherein if said detector detects dust or dirt at all of the plurality of predetermined positions, said controller sets to perform the stationary reading operation (column 5 lines 38-42).

36. Claim 48 arguments are analogous to those presented for claim 23 therefore the arguments presented for claim 23 are applicable.

With respect to claim 24 Kumagai discloses said controller turns on a flag indicative of inhibition of the read-while-feed operation upon inhibiting the read-while-feed operation, and turns off the flag upon allowing the read-while-feed operation (column 7 lines 13-16, 32-34).

37. Claim 49 arguments are analogous to those presented for claim 24 therefore the arguments presented for claim 24 are applicable.

With respect to claim 25 Kumagai discloses a flag determination unit for determining on/off of the flag indicative of inhibition of the read-while-feed operation (column 7 lines 13-16). Harada discloses wherein said apparatus is capable of performing a stationary reading operation in which an original is held at a fixed position on the platen and read while moving an image sensor (column 4 lines 52-55), and wherein said controller controls to perform the stationary reading operation when said flag determination unit determines that the flag is on, and controls to perform the read-while-feed operation when said flag determination unit determines that the flag is off (column 5 lines 20-21).

38. Claim 50 arguments are analogous to those presented for claim 25 therefore the arguments presented for claim 25 are applicable.

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**Conclusion**

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Teachey whose telephone number is 571-272-2906. The examiner can normally be reached Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RT  
Robert Teachey

KAWilliams  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER